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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,098	01/18/2002	Yuko Tsusaka	2002_0045A	6545
52349 7590 09/30/2009 WENDEROTH, LIND & PONACK L.L.P. 1030 15th Street, N.W. Suite 400 East Washington, DC 20005-1503				
EXAMINER				
SHANG, ANNAN Q				
ART UNIT		PAPER NUMBER		
2424				
MAIL DATE		DELIVERY MODE		
09/30/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/050,098

Applicant(s)

TSUSAKA ET AL.

Examiner

ANNAN Q. SHANG

Art Unit

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/01/09 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 27-30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, in claim 27 and 30, the limitations “...**which causes the content not to be reproduced...**” and “... transmit the extracted attribute data and the content to the terminal device **without transmitting the special effect data to the terminal device...**” is not supported in Applicant's disclosure.

Response to Arguments

4. Applicant's arguments with respect to claims 27-30 have been considered but are moot in view of the new ground(s) of rejection. The amendment to the claims necessitated the new ground(s) of rejection. This office action is non-final.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 27, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by **Russo (5,619,247)**.

As to claim 27, note the **Russo** reference figures 1 and 2, discloses stored program pay-per-play and further discloses contents distribution apparatus (figs.1 and 2) for distributing a content to a terminal device (Cable Box "CB" 4/Controller 10), the contents distribution apparatus comprising:

A storage section (see figs.1 and 2) operable to store therein the content and special effect data representing a special effect which causes the content not to be reproduced (col.1, lines 12-42, col.3, line 40-col.4, line 27 and line 45-col.5, line 10);
and

A transmission section operable to, when it is judged that the terminal device has

a high processing ability (Satellite, cable, analog or digital), extract, from the special effect data (high quality sound, stereo sound, analog form or digital form), attribute data including type information indicating a type of the special effect and portion information indicating a portion of the content to which the special effect is applied, and transmit the extracted attribute data and the content to the terminal device without transmitting the special effect data to the terminal device (col.1, lines 12-42, col.3, line 40-col.4, line 27, line 45-col.5, line 10, col.6, line 33-col.7, line 23 and col.10, lines 10-21), wherein the attribute data and the content transmitted to the terminal device are used, when the terminal device judged to have the high processing ability generates special effect data which is applied to the portion of the content indicated by the portion information and which represents the type of the special effect indicated by the type information, and when the terminal device judged to have the high processing ability reproduces the content to which a special effect represented by the generated special effect data is applied (col.1, lines 12-42, col.3, line 40-col.4, line 27, line 45-col.5, line 10, col.6, line 33-col.7, line 23 and col.10, lines 10-21).

As to claim 29, Russo further discloses where the special effect data is data corresponding to the portion of the content indicated by the portion information, the transmission section is further operable to transmit the special effect data and the content to the terminal device, when it is judged that the terminal device has a low processing ability, and the content and the special effect data transmitted to the terminal device are used, when the terminal device judged to have the low processing ability

reproduces the content to which the special effect represented by the special effect data is applied (col.6, line 33-col.7, line 23 and col.10, lines 10-21).

As to claim 30, the claimed "A content distribution method..." is composed of the same structural elements that were discussed with respect to the rejection of claim 27.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claim 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Russo (5,619,247)** in view of **Christopoulos et al (2001/0047517)**.

As to claim 28, Russo teaches storing different quality based upon input criteria, but silent as to a flag and where the client terminal has a low or high processing ability and controlling a flag to process the special effects data accordingly based on processing ability of the client terminal as claimed or recited, i.e., wherein the storage section is further operable to store therein a flag indicating whether or not to apply, to the content, the special effect represented by the special effect data, the transmission section is further operable to transmit the flag to the terminal device, and the flag transmitted to the terminal device is used to control whether or not to cause the terminal device judged to have the high processing ability to reproduce the content to which the special effect represented by the generated special effect data is applied.

However, note the **Christopoulos** reference figures 1-5, discloses method and apparatus for intelligent transcoding of multimedia data and further teaches storing contents and hints or special effect data and transmitting to a client device, where the client device, stores the content and hints for reproduction in accordance with the processing ability (low or high) of the client terminal, restricting a produced substance of the content and applying the transcoding hints in real time during reproduction (page 2, [0035-0036], [0039-0040], [0046] and [0048]), note that the gateway or transcoder can reside in the server or the client (where the content and special effect are received) and the special effects are applied to the terminal based on the capabilities of the terminal.

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of Christopoulos into the system of Russo in order to allow the client device to store the content and hints and dynamically modify the content with the hints data in real time in accordance with the client terminal capabilities (low or high), without having to communicate upgrade features back to the server.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Annan Q. Shang** whose telephone number is **571-272-7355**. The examiner can normally be reached on **700am-400pm**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher S. Kelley** can be reached on **571-272-7331**. The fax phone

number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the **Electronic Business Center (EBC) at 866-217-9197 (toll-free)**. If you would like assistance from a **USPTO Customer Service Representative** or access to the automated information system, call **800-786-9199 (IN USA OR CANADA) or 571-272-1000**.

/Annan Q Shang/
Primary Examiner, Art Unit 2424

Annan Q. Shang